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VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER

PWU, JEFFREY C

| ART UNIT | PAPER NUMBER |
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3628

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,147

Applicant(s)

EGGLESTON ET AL.

Examiner

Jeffrey Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17,33,34,39 and 42-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17,33,34,39 and 42-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This action is responsive to the amendment, filed 2002-12-18.
2. The allowance of claims 1-17, 33-34, 39, and 42-58 is hereby withdrawn in view of newly discovered reference Scroggie et al. and new grounds of rejections. Rejections based on the newly cited reference follow. Any inconvenience is regretted.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17, 33-34, 39, and 42-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear of how is the consumer psychographic preferences tailor to the award fulfillment program. It is also unclear what are the elements or categories of the psychographic involved. (i.e. what is the relationship among fixed determinants of the consumer decision-making process, such as price, packaging and advertising, or image or value in the psychographic decision making?)

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5. Claims 1-17, 33-34, 39, and 42-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear of how is applicant psychographically selects its customer-user(s). It is also unclear and lacks of description of how to psychographically select an abstract idea, for example, based on a persons attitudes, needs, values, and mental posture, to automate applicant's award fulfillment program.

6. Dependent claims are rejected based on their dependency on a rejected parent claim.

7. The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-17, 33-34, 39, and 42-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is vague and indefinite because it is unclear how does the automated award fulfillment program awarding its consumer-user(s). It is also unclear of how is the invention psychographically ^{or} ~~of~~ demographically profiling or selecting its customer-user(s).

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Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-17, 33-34, 39, and 42-58 are rejected under 35 U.S.C. 102(b) as being unpatentable by Scroggie (US 5,970,469).

Scroggie teaches:

Regarding claims 1-2, 39, and 42-43,

(1) A system for incentive program generation and automated award fulfillment, comprising:
a host computer coupled to a network (computer network; communication network; 304;
abstract; col.1, line 37-col.4, line 68);
a first database accessible from said host computer (502; 506; 300); and
an automated award fulfillment application program executed on said host computer (300)
for participation in incentive programs of a plurality of providers in communication with an
inventory management system associated with each of said plurality of providers wherein said
automated award fulfillment application program provides sponsor-selected (retailers; 12) fulfillment
comprising:

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providing a sponsor-selected specific award unit item, said sponsor-selected specific award unit item being tailored to demographic and psychographic preference of a sponsor-selected consumer user, and providing a sponsor-selected geographic location for fulfillment (col.6, line 35-col.7, line 53; col.13, lines 37-46).

(2) a client computer of said consumer user coupled to the network (510);
a server coupled to said host computer (310); and
a browser executing on said client computer for accessing control located on said server (140).

(39) (See col.10, line 5-col.12, line 7)
a redemption work station associated with each of said plurality of providers coupled to the network;

at least one of a number management database, coupled to the network, for adding a member record for a new member, and

an inventory management database associated with each of said plurality of providers coupled to said redemption work station; and

wherein said automated fulfillment application program for allowing designation of redemption of an award including access to any inventory management system of any of said plurality of providers and access to any member database; wherein said automated award fulfillment application program for allowing sponsor to select said award tailored to demographic and psychological preferences of the consumer user stored in at least one of any of said member

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management database and said first database accessible from said host computer, and for allowing sponsor-designation of redemption of said award at a geographic location of one of said plurality of providers; and a sponsor computer, coupled to the network, for allowing a sponsor of one of said incentive programs to designate said geographic location of redemption by the consumer user of said award.

(42) wherein said plurality of providers comprise at least one of a host, a retailer, a merchant, and a sponsor (host, supermarket retailer);

(43) wherein said system further comprises at least one of an Internet browser, an automated teller machine, a kiosk, a gasoline pump, a wireless service, a personal digital assistant, and a communication device (Internet browser; kiosks, at col.1 lines 10-25; 410).

Regarding claims 3-5, and 44-45:

(3) providing a host computer, the host computer having a database and an automated award fulfillment application program in communication with an inventory management system associated with each of a plurality of providers (300; also see fig.3; it is inherent that the manufacture or retailers' automated award fulfillment application program are in communication with the inventory management system to promote customer's buying incentives);

said automated award fulfillment for providing sponsor-selected fulfillment comprising:

providing a sponsor-selected specific award unit item, providing said sponsor-selected specific award unit item tailored according to demographic and psychographic preferences of a

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sponsor-selected consumer user, and providing a sponsor-selected graphic location for fulfillment; and permitting access to said database via a network, including allowing participation in incentive programs of said plurality of providers (col.6, line 35-col.7, line 53; col.13, lines 37-46).

(4) providing a network coupling said host computer to a workstation for transferring electronic data between said work station with an application program for responding to input from said host computer or said work station (see fig.3);

allowing a user of said computer to operate said automated award fulfillment application program to generate an incentive program and to store said incentive program on said host computer (col.7, line 5-col.8, line 9);

transferring a stored incentive program to said work station (300, 306; fig.13); and

providing an address for said stored incentive program to permit access to said stored incentive program from said network (see household registration; col.9, lines 15-41).

(5) providing at least one of an award association application program that associates an award with said incentive program, and an award fulfillment association application program that associates a fulfillment option with an award (fig.13).

Claims 6-10, and 46-48 are similarly rejected as in claims 1-5 and 39, and 42-45:

(6) A system for automating award fulfillment, comprising:

a network;

a host computer, coupled to said network;

a first database of said host computer;

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a browser operative to browse content of said host computer, wherein a consumer user participates in an incentive program;

an award database of awards associated with said incentive program; and an automated award fulfillment application program for automating fulfillment of awards of said incentive program, in communication with an inventory management system associated with each of a plurality of providers wherein said automated award fulfillment application program provides sponsor-selected fulfillment for providing a sponsor-selected specific award unit item;

providing said sponsor-selected specific award unit item tailored to demographic and psychographic preferences of a sponsor-selected consumer user, and providing a sponsor-selected geographic location for fulfillment.

(7) a card for fulfillment of awards won in said incentive program.

(8) a memory for storing at least a personal identification number associated with said sponsor-selected consumer user for use in performing fulfillment.

(9) memory for storing information relating to participation of said sponsor-selected consumer user in an incentive program.

(10) said browser, coupled to said host computer, wherein said consumer user participated in incentive programs of at least two providers via said browser.

Claims 11-17 are similarly rejected as in claims 1-5 and 39, and 42-45:

(11) automating award fulfillment, including: providing a host computer;

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providing an incentive program on the host computer, wherein a participant may participate in said incentive program;

providing a database of awards on the host computer associated with the incentive program;

providing automated fulfillment of said awards to participants, including:

providing communication with an inventory management system associated with each of a plurality of providers wherein said automated award fulfillment application program comprising:

providing sponsor-selected fulfillment for:

a sponsor-selected specific award unit item;

providing said sponsor-selected specific award unit item tailored according to demographic and psychographic preferences of a sponsor-selected consumer user, and providing a sponsor-selected geographic location for fulfillment.

(12) wherein said database of awards includes awards from a plurality of sponsors.

(13) wherein said providing automated fulfillment comprises: associating an award with the incentive program; and associating a fulfillment method with the award.

(14) providing a card comprising memory for storing data associated with a user.

(15) providing an optimization application program that identifies an award based on the geographic proximity of an award winner to redemption location of an award in the database of awards.

(16) wherein the database is a personal identification number.

(17) wherein said data is information to a user's participation in an incentive program.

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Claims 33-, 34, and 49-58 are similarly rejected as in claims 1-5 and 39, and 42-45.

☞ Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey ^{PWU}PAU whose telephone number is (703) 308-7835.

Jeffrey Pwu



11 April 2003

**JEFFREY PWU
PRIMARY EXAMINER**